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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,263	01/27/2004	Claus Meese	55647-C (45107)	3433
21874	7590	11/29/2004		EXAMINER
				TUCKER, ZACHARY C
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/766,263	MEESE ET AL.	
	Examiner	Art Unit	
	Zachary C. Tucker	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 27 October 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 28-49 is/are pending in the application.
4a) Of the above claim(s) 30,33-35,38,40,44 and 45 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 28,29,31,41 and 42 is/are rejected.
7) Claim(s) 32,36,37,39,43 and 46-49 is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. 09/700,094.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 28, 29, 31, 32, 36, 37, 39, 41-43 and 46-49, all in part) in the reply filed on 27 October 2004, to the Requirement for Restriction mailed 28 September 2004, is acknowledged.

The examiner notes that the alternative identity for R and R' in Group I of the Requirement for Restriction was erroneously set forth. Group I also includes those compounds where one or both of R and R' are allyl.

Claims 30, 33-35, 38, 40, 44 and 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41 specifies in the preamble that a method of producing ethers is provided, while the process step recited is that of an esterification reaction. Thus, the preamble is repugnant to the actual process claimed. Claim 41 has not been further examined on the merits in this Office action.

Claim 42 also specifies in the preamble that a method of producing ethers is provided, while it is clear from a reading of the claim that the actual process steps

produce many compounds in addition to ethers. For example, reactants (c) and (f) would produce esters, reactant (e) would produce a carbamate or carbonate.

Claim 42 is further indefinite because the term "suitable hydroxy reagents" is not understood to be a term of art. The specification does not provide sufficient definition of what compounds belong to this class of reagent. Page 32 suggests that these reagents include alcohols, but no further description of the assumedly broad class of "suitable hydroxy reagents" is given. Thus, the full scope of what applicants intend "suitable hydroxy reagent" to encompass is unclear. Replacement of the phrase with "suitable alcohol" would be sufficient to overcome at least this ground of rejection.

Claim 42 has not been further examined on the merits in this office action because it is unclear what compounds are produced by the process when the above pointed-out reactants are employed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28, 29 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,686,464 (Johanssen et al).

In column 9, lines 4-16, the preparation of the compound (-)-N,N-diisopropyl-3-(2-benzyloxy-5-hydroxymethyl)-3-phenylpropylamine is disclosed.

The (+) isomer is also prepared in an analogous manner.

These compounds are compounds according to claims 28, 29 and 31 where R' (claims 28 and 29) or R¹¹ (claim 31) is benzyl, R (claims 28 and 29) or R¹⁰ (claim 31) is hydrogen and X in claim 28 is diisopropylamine.

Claim Objections

Claim 32 is objected to because non-elected subject matter is recited.

The first five named species in claim 32 are within the elected group ^{and} ¹ are allowable, however.

Claims 36 and 37 are objected to because non-elected subject matter is recited.

Claims 36 and 37 would be allowable if amended to delete non-elected subject matter. A composition comprising allowable compounds of claims 32, 36 and 37 (as specified in claim 39) and methods as specified in claims 46-49, commensurate in scope with the allowable compounds would be allowable as well.

There is no disclosure of nor any suggestion to make a compound according to claims 32 (first five species), 36 or 37 in the prior art.

Claims 39, 43 and 46-49 are objected to because they depend from a rejected base claim and also recite non-elected subject matter, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and to delete non-elected subject matter.

Comments

Although not applicable as prior art, US 6,313,132 (Johansson et al) discloses the second named species in instant claim 32, and includes a claim to this species in claim 19 of that patent (it is the 9th named species).

It appears that US 6,313,132 and the instant application do not have any inventors in common and are not commonly owned.

Applicant is on notice that a potential case of interference exists.

Conclusion

Any inquiry concerning this communication should be directed to Zachary Tucker whose telephone number is (571) 272-0677. The examiner can normally be reached Tuesday-Thursday from 6:15am to 2:45pm, Monday from 6:15am to 1:45pm and Friday from 6:15am to 3:45pm (EST). If Attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mukund Shah, can be reached at (571) 272-0674.

If, after a 24-hour period, Dr. Shah is unreachable, contact the examiner's acting supervisor, James O. Wilson, at (571) 272-0661.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and (703) 308-4242 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2717.

zt

zth


RICHARD L. RAYMOND
PRIMARY EXAMINER
ART UNIT 1624